



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/561,734

06/12/2006

John Hesketh

04150.0003U2

7801

23859

7590

11/26/2008

Ballard Spahr Andrews & Ingersoll, LLP  
SUITE 1000  
999 PEACHTREE STREET  
ATLANTA, GA 30309-3915

EXAMINER

DESAI, ANAND U

ART UNIT

PAPER NUMBER

1656

MAIL DATE

DELIVERY MODE

11/26/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/561,734	<b>Applicant(s)</b> HESKETH ET AL.	
	<b>Examiner</b> ANAND U. DESAI	<b>Art Unit</b> 1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 16-24 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 25 and 27-29 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20070709</u> .                                                | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 1656

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of group I, drawn to a method of producing a target protein in the reply filed on December 3, 2007 is acknowledged. Applicant's election of SEQ ID NO: 1 as the species is acknowledged. The traversal is on the ground(s) that the examiner has not shown that a serious burden would be required to examine all the claims. This is not found persuasive because the application lists inventions that do not relate to a single general inventive concept. The technical feature does not constitute an advance over the prior art (see page 3 of Restriction office action mailed October 3, 2007).

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 16-24 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 3, 2007.
3. Claims 1-15, 25, and 27-29 are currently under examination.

### ***Priority***

4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The priority date is June 25, 2003.

***Information Disclosure Statement***

5. The information disclosure statement (IDS) submitted on July 9, 2007 is being considered by the examiner. A signed copy of the 1449 form is attached with the office action.

***Drawings***

6. The drawings are objected to because Figure 1 discloses amino acid sequences without SEQ ID NO: identifiers. Suggest either identifying the SEQ ID NOs for the respective sequences in the figures or in the brief description of the drawing section of the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

7. The disclosure is objected to because of the following informalities:
8. There is no section identified as brief description of the drawings. Suggest identifying the brief description of the drawing section.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
10. Claims 1-15 and 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
11. The term "majority" in claim 7 is a relative term which renders the claim indefinite. The phrase "of the native protein" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear how much of the native protein can be included within the chimeric protein.
12. In claim 27, it is unclear how the signal peptide is from the bulk-secreted protein and the target protein. It appears the signal peptide should be from the taxonomically distinct bulk-secreted protein.
13. The term "bulk" in claims 1 and 27 is a relative term which renders the claim indefinite. The term "secreted protein" is not defined by the claim, the specification does not provide a

Art Unit: 1656

standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. What amount of a secretion is encompassed by a bulk-secreted protein?

14. Dependent claims are rejected for failing to cure the indefiniteness of the rejected claim.

***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

15. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

16. Claims 13 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are rejected for failing to describe a representative genus of fragments, derivatives, and variants of the SEQ ID NOs encompassed by the claims. The disclosure does not provide sufficient structure to function correlation for the genus of fragments, derivatives, and variants thereof that will maintain the signal sequence function.

The MPEP states that the purpose of the written description requirement is to ensure that the inventor had possession, at the time the invention was made, of the specific subject matter claimed. The courts have stated:

"To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that

Art Unit: 1656

"the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); *In re Gostelli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966." *Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398.

Further, for a broad generic claim, the specification must provide adequate written description to identify the genus of the claim. In *Regents of the University of California v. Eli Lilly & Co.* the court stated:

"A written description of an invention involving a chemical genus, like a description of a chemical species, 'requires a precise definition, such as by structure, formula, [or] chemical name,' of the claimed subject matter sufficient to distinguish it from other materials." *Fiers*, 984 F.2d at 1171, 25 USPQ2d 1601; *In re Smythe*, 480 F.2d 1376, 1383, 178 USPQ 279, 284985 (CCPA 1973) ("In other cases, particularly but not necessarily, chemical cases, where there is unpredictability in performance of certain species or subcombinations other than those specifically enumerated, one skilled in the art may be found not to have been placed in possession of a genus ...") *Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398.

MPEP § 2163 further states that if a biomolecule is described only by a functional characteristic, without any disclosed correlation between function and structure of the sequence, it is "not sufficient characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence." MPEP § 2163 does state that for a generic claim the genus can be adequately described if the disclosure presents a sufficient number of representative species that encompass the genus. If the genus has a substantial variance, the disclosure must describe a sufficient variety of species to reflect the variation within that genus. See MPEP § 2163. Although the MPEP does not define what constitute a sufficient number of representative species, the courts have indicated what do not constitute a representative number of species to

Art Unit: 1656

adequately describe a broad generic. In *Gostelli*, the courts determined that the disclosure of two chemical compounds within a subgenus did not describe that subgenus. *In re Gostelli*, 872, F.2d at 1012, 10 USPQ2d at 1618.

As stated *supra*, the MPEP states that written description for a genus can be achieved by a representative number of species within a broad genus. Claims 13 and 14 are broadly generic to all possible modifications of amino acids as encompassed by the claims. The possible variations are enormous. Since the MPEP states that if a biomolecule is described only by a functional characteristic, without any disclosed correlation between function and structure, it is "not sufficient characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence." MPEP § 2163. Here, though the claims may recite some functional characteristics, the claims lack written description because there is no disclosure of a correlation between function and structure of fragments, derivative, and variants thereof beyond those disclosed in the examples in the specification. Moreover, the specification lacks sufficient variety of species to reflect this variance in the genus.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736, F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.") Accordingly, it is deemed that the specification fails to provide adequate written description for the genus of the claims and does not reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the entire scope of the claimed invention.



***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 1, 4-7, 9, 15, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Allet et al. (Protein Expression and Purification 9: 61-68 (1997); Previously cited).

Allet et al. disclose the use of a bacterial signal peptide sequence to direct efficient secretion of eukaryotic proteins in Baculovirus expression system. Allet et al. disclose the use of signal sequence from Staphylococcal protein A fused with eukaryotic proteins for expression in Baculovirus insect expression cells (see page 62-63, Materials and Methods section). The signal sequence was 36 amino acids in length (see page 65, Figure 2). Figures 4 and 5 show the purification of fusion proteins from expression system (see page 66).

19. Claims 1-7 and 15 are rejected under 35 U.S.C. 102(a) as being anticipated by Brumell et al. (Traffic 4: 36-48 (Jan. 2003)).

Brumell et al. disclose a SopD2 protein that is a novel type III secreted effector of *Salmonella typhimurium* that targets late endocytic compartments upon delivery into host cells. Brumell et al. disclose the synthesis of N-terminal truncated SopD2 fusion proteins with GFP. Brumell et al. disclose the transfection of mammalian HeLa cells with SopD2-GFP chimeric

Art Unit: 1656

proteins, wherein the SopD2 portion provides a signal sequence (see page 43, Figure 3, and Materials and Methods section, Cell culture section).

20. Claims 1, 2, 4-6, and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Bryan (U.S. Patent 6,416,960 B1).

Bryan discloses the synthesis of conjugated proteins comprising *Vargula hidgendorfi* luciferase. The conjugated luciferase protein comprises the secretion signal of the ostracod secreted luciferase sequence. The luciferase can be produced using recombinant technology in mammalian host cells (see col. 25, lines 30-63).

#### ***Claim Objections***

21. Claim 25 is objected for depending on a withdrawn claim.

#### ***Conclusion***

22. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANAND U. DESAI whose telephone number is (571)272-0947. The examiner can normally be reached on Monday - Friday 9:00 a.m. - 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber can be reached on (517) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1656

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

November 23, 2008

/ANAND U DESAI/

Primary Examiner, Art Unit 1656